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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

GARG, YOGESH C

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 10/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/492,844

Applicant(s)

RONNING ET AL.

Examiner

Yogesh C Garg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 July 2004.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,8,14-16,23,25,30 and 36-38 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1,3,8,14-16,23,25,30 and 36-38 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Priority

1. The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application); the disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994). The subject matter of the currently amended independent claims 1 and 23, that is “permitting download of the file based on a number of attempted downloads of the file by the user and a number of successful downloads of the file by the user”, is not supported by the provisional application 60/110,952, filed on December 4, 1998 and non-provisional application 09/372,253 filed on 08/11/1999. Therefore currently amended claims 1, 3, 8, 14-16, 23, 25, 30, and 36-38 do not qualify to claim priority to the filing dates of the provisional application 60/110,952, filed on December 4, 1998 and non-provisional application 09/372,253 filed on 08/11/1999 to comply with the requirements of the first paragraph of 35 U.S.C. 112.

Response to Amendment

2. Amendment received on July 2, 2004 is acknowledged and entered. Claims 9, 17, 19, 22, 31, 39, 41, and 44 are currently cancelled. Claims 1 and 23 are currently

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amended. Currently claims 1, 3, 8, 14-16, 23, 25, 30, and 36-38 are pending for examination.

Response to Arguments

3.1 Applicant's arguments and currently amended claims, see Remarks on page 6, filed July 2, 2004, with respect to rejection of claims 1, 3, 8-9, 14-16, 23, 25, 30-31, 36-38 under 35 U.S.C. 112, first paragraph have been fully considered and are persuasive. The rejection of claims 1, 3, 8-9, 14-16, 23, 25, 30-31, 36-38 under 35 U.S.C. 112, first paragraph of has been withdrawn.

3.2 Applicant's arguments filed on July 2, 2004, see Remarks on pages 6-7, concerning amended independent claims 1 and 23 and the reference Downs have been considered but are moot in view of the new ground(s) of rejection necessitated due to current amendments.

Claim Rejections - 35 USC § 101

4 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 3, 8, and 14-16 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

4.1. Claimed Invention(s) does not fall within the Technological Art.

As an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof." Therefore, a fundamental premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that promote the progress of "science and the useful arts". The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first test of whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See *Diamond v. Diehr*, 450 U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).

This "two prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI). See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held

that the recited mathematical algorithm did not render the claim as a whole non-statutory using the Freeman-Walter-Abele test as applied to *Gottschalk v. Benson*, 409 U.S. 63, 175 USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the claimed subject matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. In *re Toma* at 857.

In *Toma*, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.

The decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* never addressed this prong of the test. In *State Street Bank & Trust Co.*, the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See *State Street Bank & Trust Co.* at 1374. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "[w]hether the patent's claims are too broad to be patentable is not to be judged under §101, but rather

under §§102, 103 and 112." See *State Street Bank & Trust Co.* at 1377. Both of these analysis goes towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, *State Street* abolished the Freeman-Walter-Abele test used in *Toma*. However, **State Street never addressed the second part of the analysis, i.e., the "technological arts" test established in *Toma* because the invention in *State Street* (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under the *Toma* test. This dichotomy has been recently acknowledged by the Board of Patent Appeals and Interferences (BPAI) in affirming a §101 rejection finding the claimed invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).**

In the present application, Claims 1, 3, 8, and 14-16 have no connection to the technological arts. None of the steps indicate any connection to a computer or technology. The step of receiving, verifying, determining, permitting, displaying transmitting and denying could be performed manually by people without the use of computers or technology. Therefore, the claims are directed towards non-statutory subject matter. To overcome this rejection the Examiner recommends that Applicant amend the claims to better clarify which of the steps are being performed within the technological arts, such as incorporating/integrating a computer/software/hardware computer network or electronic network functionally with manipulative steps recited in the claims.

Note: The above 101 rejection has arisen due to current amendment by canceling the limitation, " during the on-line session" from independent claim 1.

5. Examiner cites particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Claim Rejections - 35 USC § 103

6 The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6.1. Claims 1, 3, 8, 14-16, 23, 25, 30, and 36-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Downs and further in view of Pitts et al. (US Patent 4,893,248), hereinafter, referred to as Pitts.

Regarding claims 1, 3, 8, 16, Downs teaches a method for secure downloading of a file from a network comprising: receiving a selection of a file, receiving an order from a user, during an online session, for download of the selected file, the order

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including a file identifier related to the file and an order identifier related to the order, verifying the file identifier based upon particular information related to the file comprising one or more of the following: verifying a version identifier related to the file, a uniform resource locator for the file; or verifying the order identifier based upon particular information related to the order comprising a custom identifier associated with the user, verifying a transaction identifier associated with the order, and the particular information related to the order including: determining if the order identifier is valid for the order, meaning the order identifier exists for the order, determining if the order identifier is active, meaning the order was not canceled before the download of the file, and determining if the order identifier is non-suppressed, meaning the order was not canceled after the download of the file, during the online session, and selectively permitting the download of the file based upon a number of requested downloads based upon the verification of the file identifier, transaction identifier and the order identifier, receiving a selection of a uniform resource locator for the file and determining if the uniform resource locator is valid, active, non-suppressed or charged, also selectively downloading the file based upon a number of successful downloads of the file and upon a time parameter related to submission of the order, and denying the download based upon a customer identifier associated with the user (at least see, col.3, lines 40-55,*transferring the encrypted data....clearing house.....transferring the re-encrypted data.....to the user's system.....*". col.7, lines 2-16, "*..licensing authorization and control....conditions of purchase and license, such as permitted number of copies, number of plays, and the time interval or term the license may be validenabling*

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intermediate or End-User (s) to unlock content after verification of a successful completion of licensing transaction..”, col.8, lines 26-31, “..The architecture is open...Distribution of audio, programs, multimedia, video or other types of Content....”, col.10, lines 19-26, “... Once an Electronic Digital Content Store(s) 103 completes a valid request for Electronic Content 113 from an End-User(s).....The Electronic Digital Content Stores (s) also authorizes the download of the SC containing the Content 113 “, col.11, lines 30-54, “..The End-User Device(s) 109 can be any player device.....The End-User device (s) 109 manages the download and storage of SCs containing the Digital Content.....the use or running-on an End-User device(s) “, col.24, lines 17-47, “... Upon reception of the Order SC9s) 650 from the Ned-User Devices (09), the Clearinghouse (s) 105 verifies:2. that the order SC (s) 650 has not been altered.....Transaction Data 642 and Symmetric Key 623 are complete and authentic.....If the verifications are successful.....transfers the License SC (s) 660 to the End-User Device (s) 109....”, col.26,lines 24-58, “...When an End-User Devices (109 receives the Content.....Instead, the SC (s) includes an external URL.....to point to the Content 113.....Electronic Digital Content Store (s) 103 also.....extracting metadata information from them to build HTML pages.....present descriptions of Content 113 to End-User (s), usually so they can purchase the Content 113 “, col.27, lines 6-21, “..The End-User device (s) 109 receives the Transaction SC (s) 640 and validates the integrity of the Transaction SC (s) 640 and the included Offer SC (s) 641.....The Clearinghouse (s) 105 validates and processes Order Sc (s) 650...access purchase Content 113 “, col.28, lines 30-50, “...Each record includesa URL that

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points to another SC (s) that includes the encrypted part...", col.29 line 18-col.30, line 62, "...[Content URL]....Content ID- A part that defines a unique ID assigned to a Content 113 item....SC Version-A version number assigned to the SC (s)...SC ID---", col.33, line 25-col.34, line 50, "...Transaction ID 535...End-User (s) ID---Verify the Digital Signature 643 of the SC (s).....Verify the integrity and authenticity of each Offer SC (s) 641 included in the Transaction Sc (s) 640...", col.40, line 35-col.41, line 4, "...The ID property is a unique value ...T property specifies the type of the SC (s)...A property identifies the author or publisher....D property identifies the date...E property identifies the date, and optionally, the time that the SC (s) expires...CCURL value...CCURL property identifies the URL of the Clearinghouse (s) 105. The value should be the form of a valid external URL...", col.44, lines 5-42, "... Validation....The Clearinghouse(s) 105 begins the validation of Order SC 9s) 650 by verifying the digital signatures.....integrity of the Order SC (s) 650 parts...The process of verification of the Transaction and the Offer Sc (S)Then, the Storage Usage Conditions 519 of the Content 113...are validated by the Clearinghouse (s) 105.....", col.45, lines 15-28, "...In all the processing of the Order SC (s) 650 is successful...If the Clearinghouse (s) 105 is not able to successfully process the order SC (s) 650.....The HTML page indicates the reason that the Clearinghouse (s) 105 was unable to process the transaction ", col.46, lines 5-61, col.50, line 34-col.51, line 39, col.54, lines 55-64, col.59, line 7-col.60, line 13, col.72, lines 11-59, col.75, line 1-col.77, line 23, col.79, line 10-col.89, line 20.). Downs further teaches determining if an order identifier is also active-corresponding order must not have been canceled before downloading the ordered file, and non-suppressed -

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order must not have been canceled after downloading the ordered file, (see Downs at least col.10, line 50-col.11, line 27, wherein Downs teaches that the Clearinghouse (s) 105 checks all transactions relating to sale before authorizing license and later checks if the user is permitted to use the authorized license and this corresponds to checking if the order is canceled before and after the order. Also see at least col.6, line 65-col.8, line 5, col.10, lines 19-48, col.81, line 10-col.82, line 22, col.85, lines 53-63.).

Downs does not teach permitting download of the file based on a number of attempted downloads of the file by the user and a number of successful downloads of the file by the user.

However, in the analogous field of endeavor, that is downloading Pay per view TV programs to remote terminals, Pitts discloses permitting download of the file based on a number of attempted downloads of the file by the user and a number of successful downloads of the file by the user (see at least col.5, line 4-col.6, line 33, "*In accordance with these and other objects of this invention, there is provided a system for monitoring and accumulating data indicative of viewer authorized pay per view TV programs at each of a plurality of remote terminals, wherein each remote terminal is coupled illustratively by non-dedicated telephone lines to a host computer at a central station. Security features are adopted for the remote terminal of this invention to prevent viewer interference with the monitoring and/or reporting of the report message to the host computerIn a still further feature of this invention, each viewer is given a credit limit illustratively as the number of pay per view TV programs that will be authorized before it is necessary to update that credit limit..... In an illustrative embodiment of this invention, if either the credit limit and/or the number of times that no carrier tone has been sensed exceed preset limits, the remote terminal defeats the further authorizing of pay per view programs..A request message may also be transmitted to the initializing computer, if the remote terminal is unable to*

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connect over the telephone lines with its host computer, e.g., the remote terminal has tried a predetermined number of times without succeeding to place a telephone call to its host computer. “.

Note: The credit limit in Pitts correspond to the number of times a user is allowed to successfully receive or download programs and if that limit is exceeded the system stops the authorization. The system also monitors the unsuccessful attempts to receive or download the program and this is communicated to the host computer for further suitable action).

In view of Pitts, it would have been obvious to one of an ordinary skill in the art at the time of the invention to have modified Downs to incorporate the feature of permitting download of the file based on a number of attempted downloads of the file by the user and a number of successful downloads of the file by the user. Doing so helps the system in many ways; (i) to monitor and accumulate data on the user's use of receiving and downloading TV programs, (ii) to stop unauthorized receiving and downloading TV programs and alert and prompt the user to renew his subscription for receiving and downloading TV programs, (iii) in case if the user is not able to access the system for receiving and downloading TV programs the system can be informed for corrective action, and (iv) to stop users from tampering with the system, as explicitly disclosed in Pittes, see col.4, line 46-col.6, line 33 and col.16, line 17-col.18, line 3.

6.2. With regards to claims 14-15, the steps of requesting identification of a file name for storing the file, displaying a default identification as the file name for storing

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the file based upon an identification of the file and transmitting the generated file identifier for display to the user are inherent during the download.

6.3. With regards to apparatus claims 23, 25, 30, and 36-38, their limitations correspond to method claims 1, 3, 8, 14-16, and are, therefore, analyzed and rejected similarly.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

(i) US Patent 6,044,471 to Colvin discloses a method and apparatus to monitor and identify unauthorized downloading of software so as to deactivate/disable the downloading process and take further action for requesting payment from the user or seek civil or criminal penalties (see at least col.1, line 60-col.6, line 11).

(ii) US Patent 6,263,446 to Kausik et al. discloses a method and apparatus to monitor and identify a number of unsuccessful attempts while downloading data from a smart card so as to lock the card after a small number of successive missed attempts (see at least col.1, lines 56-64).

(III) US Patent 6,697,948 to Rabin et al. discloses a method and system to protect the unauthorized downloading and use of software from hackers and customers (See at least col.2, line 10-col.3, line 13).

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8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

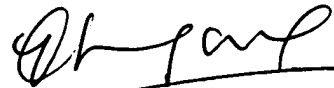
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C Garg whose telephone number is 703-306-0252. The examiner can normally be reached on M-F(8:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent A Millin can be reached on 703-308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Yogesh C Garg
Primary Examiner
Art Unit 3625

YCG
September 26, 2004